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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,236	02/11/2002	Hideharu Tanaka	8013-1013	9570

466 7590 10/03/2003

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EXAMINER	
WEIER, ANTHONY J	
ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/049,236	TANAKA, HIDEHARU	
	Examiner	Art Unit	
	Anthony Weier	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "the main components" lacks antecedent basis.

In claim 10, it is not clear what alternatives are being presented.

In claim 12, "the solid of the soymilk" and "the resulting mixture" lack antecedent basis. Also, it is not clear as to how adding the sweetener and mix materials is "for heating and agitation."

In claim 19, "the resulting mixture" lacks antecedent basis.

Claim 21 is indefinite in that it refers to "the mix material" in singular when claim 12 calls for the plural form.

In claims 22 and 23, "the ice cream merchandise standards" lacks antecedent basis. Also, such terminology is indefinite since it is not clear what scope of standards this would encompass.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 10, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naruse (JP 58212749) taken together with Zemel et al.

Naruse discloses a ice cream made with potato puree. Naruse is silent regarding the use of soybean in said ice cream. However, it is notoriously well known to

employ soybean milk as a milk substitute in ice cream as taught, for example, by Zemel et al. It would have been obvious to one having ordinary skill in the art at the time of the invention to have substituted soymilk in the ice cream of Naruse to provide, for example, an ice cream alternative for people who are lactose intolerant (e.g. col. 1).

The claims further call for particular amounts of various ingredients. However, absent a showing of unexpected results, it would have been further obvious to have arrived at such amounts as a matter of preference depending on the particular degree of flavoring, textures, etc. desired.

Claims 10 further calls for the inclusion of antioxidants of vegetables or cereals. However, such are notoriously well known in food products including ice cream, and it would have been further obvious to have included same for their art recognized function.

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied in paragraph 2 further in view of JP 61-96953 and Serpelloni.

The claims further call for the use of sweet potato as the particular potato employed. However, it is known to incorporate sweet potato in ice cream as taught, for example, by JP 61-96953. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included sweet potato as a matter of preference depending on the particular potato taste desired in the ice cream.

The claims further call for the presence of oligosaccharide as a sweetener. It is well known to employ oligosaccharides in ice cream as taught, for example, by Serpelloni et al. It would have been obvious to one having ordinary skill in the art at the

time of the invention to have employed same for its sweetening and textural benefits as set forth in Serpelloni et al (e.g. col. 1, lines 44-65).

4. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied in paragraph 2 further in view of either one of Mitchell et al or Buttermann III.

The claims further call for the inclusion of apple (or fruit with sourness) in the ice cream. However, it is well known to employ apple in ice cream as taught, for example, by Mitchell et al and Buttermann III. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included an apple material in ice cream for flavoring as taught in Mitchell et al and Buttermann III and binding as further taught in Mitchell et al.

The claims further call for particular amounts of various ingredients and the content of solid ice cream. However, absent a showing of unexpected results, it would have been further obvious to have arrived at such amounts as a matter of preference depending on the particular degree of flavoring, textures, etc. desired.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied in paragraph 2 further in view of Takemoto et al.

Claim 11 further calls for the use of momordicae fructus as an added sweetener. However, momordicae fructus is a known sweetener as taught, for example, by Takemoto et al. Absent a showing of unexpected results, it would have been obvious to one having ordinary skill in the art at the time of the invention to have employed momordicae fructus in ice cream for its art recognized sweetening ability.

6. Claims 13-21 and 23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 12 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

The prior art of record does not disclose nor teach the particular method of preparing an ice cream containing primarily soy milk and potato material in the particular manner as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 703-308-3846. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3602 for regular communications and 703-305-3602 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

Anthony Weier

Primary Examiner

Art Unit 1761

9/26/03

Anthony Weier

September 26, 2003